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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/840,648	04/23/2001	Brian Fitzpatrick	MRZ 8996.1	5040
321	7590	07/12/2006	EXAMINER	
SENNIGER POWERS ONE METROPOLITAN SQUARE 16TH FLOOR ST LOUIS, MO 63102			VAN BRAMER, JOHN W	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 07/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/840,648	Applicant(s) FITZPATRICK ET AL.	
	Examiner John Van Bramer	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24, 39 and 52-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24, 39 and 52-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>042706</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed on April 27, 2006, cancelled claims 25 – 38 and 40 – 51. Claims 1, 24, 39 and 52 – 54 were amended and claim 55 has been added. Thus, the currently pending claims are 1-24, 39, and 52-55.

Information Disclosure Statement

2. The amendment filed on April 27, 2006 corrected the deficiencies identified in the Information Disclosure Statement dated September 14, 2001. A copy of the "Build a Contest" prior art has been received, however, the examiner has no method in which to verify the claimed date of April 5, 2000 on which the document is purported to have been printed from the www.salesdriver.com website.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 55 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the

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invention. Claim 55 recites "said storage device and said program processor responsive to the program supplier" the examiner cannot determine what interactions the program supplier is performing on the device and the program processor. No steps are provided that would enable the storage device and program processor to responsively interact with the program supplier. All recited steps are directed, instead, toward actions allowing the first customer, and second customer to interact with the storage device and program processor.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 55 recites the limitation "their program" in lines 4 - 5. There is insufficient antecedent basis for this limitation in the claim. The customers create individual motivation or recognition program that have participants, the participants do not possess ownership in the program as the statement suggests. The examiner suggests changing this phrase to recite "the program in which they participate".

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, 3-24, and 52-55 are rejected under 35 U.S.C. 102(e) as being anticipated by Eggleston et al. (U.S. Patent Number: 6,061,660).

Claim 1: Eggleston discloses a method for allowing multiple customers to each create an individual, modified motivation or recognition program having participants, each said program permitting the participants to earn awards on the basis of the participants' performance, each said program of a particular customer operating according to preferences selected by the particular customer, said method comprising the steps of:

- a. Allowing each customer to electronically access via a customer processor a browsable catalog of predefined programs stored in a storage device; allowing each customer to electronically select via the customer processor one of the predefined programs stored in the storage device (Col 14, lines 6-65)
- b. Allowing each customer to electronically modify via the customer processor at least one component of the selected predefined program. (Col 14, lines 6-65)
- c. Allowing each customer to electronically store via the customer processor the modified program in the storage device for access by such customer; allowing each customer to operate the modified program via the program processor, and wherein the participant processor and the customer processor are remote from

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said program processor and remote from the storage device connected to the program processor. (Col 10, lines 28-42; Col 12, lines 38-48; and Col 14, lines 6-65)

- d. Providing each customer's participants with access via a participant processor to the modified program stored in the storage device. (Col 14, lines 6-65)

Claim 3: Eggleston discloses the method of claim 1, wherein the awards are award points, and wherein the providing step comprises the step of electronically providing each customer's participants with access to a browsable catalog of award items which may be obtained by the participant. (Col 12, line 58 through Col 13, line 6)

Claim 4: Eggleston discloses the method of claim 3, further comprising the step of allowing each customer's participants to electronically redeem the award points for the award items. (Col 21, line 29 through Col 22, line 32)

Claim 5: Eggleston discloses the method of claim 3, further comprising the step of allowing each participant to view data indicating the amount of the award points of such participant. (Col 16, line 46 through Col 17, line 8)

Claim 6: Eggleston discloses the method of claim 3, further comprising the step of allowing each participant to view data indicating transactions by such participant. (Col 16, line 46 through Col 17, line 8)

Claim 7: Eggleston discloses the method of claim 1, wherein the step of allowing each customer to operate the modified program further includes the step of allowing a program processor to generate electronic progress reports for the participants in the modified program indicating program information. (Col 16, line 46 through Col 17, line 8)

Claim 8: Eggleston discloses the method of claim 1, wherein the step of allowing each customer to operate the modified program further includes the step of assessing the customer a fee for the awards as the awards are earned by the participants. (Col 14, line 6 through Col 15, line 15)

Claim 9: Eggleston discloses the method of claim 1, wherein prior to the step of allowing each customer to operate the modified program, including the step of allowing the customer to create or review a proposal and/or invoice relating to the modified program. (Col 14, line 6 through Col 15, line 15)

Claim 10: Eggleston discloses the method of claim 1, further comprising the step of allowing each customer to create and receive via electronic mail a proposal and/or invoice relating to the modified program for offline review. (Col 17, line 52 through Col 18, line 31)

Claim 11: Eggleston discloses the method of claim 1, wherein prior to the step of allowing each customer to operate the modified program, including the step of allowing each customer to purchase the use of the modified program. (Col 17, line 52 through Col 18, line 31)

Claim 12: Eggleston discloses the method of claim 1, wherein prior to the step of allowing each customer to operate the modified program, including the step of assessing a fee relating to the modified program. (Col 17, line 52 through Col 18, line 31)

Claim 13: Eggleston discloses the method of claim 12, wherein prior to the step of assessing a fee relating to the modified program, including the step of allowing each customer to create or review a proposal and/or invoice associated with the modified program. (Col 17, line 52 through Col 18, line 31)

Claim 14: Eggleston discloses the method of claim 12, wherein prior to the step of assessing a fee relating to the modified program, including the step of defining the communications campaign of the modified program. (Col 19, lines 32-55)

Claim 15: Eggleston discloses the method of claim 1, wherein the browsable catalog of predefined programs has a plurality of business challenges, and further comprising the step of allowing each customer to select one of the business

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challenges to reduce the number of predefined programs of the browsable catalog, which may be selected. (Col 19, line 56 through Col 20, line 32)

Claim 16: Eggleston discloses the method of claim 1, wherein the browsable catalog of predefined programs has a plurality of program types, and further comprising the step of allowing each customer to select one of the program types to reduce the number of predefined programs of the browsable catalog, which may be selected. (Col 19, line 56 through Col 20, line 32)

Claim 17: Eggleston discloses the method of claim 1, wherein each predefined program has a plurality of program components, and further comprising the step of allowing each customer to select at least one of the program components to modify the predefined program. (Col 18, line 64 through Col 19 line 31)

Claim 18: Eggleston discloses the method of claim 1, further comprising the step of enrolling participants in the modified program. (Col 13, lines 7-28)

Claim 19: Eggleston discloses the method of claim 1, further comprising the step of allowing the customer to define participant objectives to be associated with the modified program. (Col 14, lines 26-49)

Claim 20: Eggleston discloses the method of claim 1, wherein a predetermined event is defined, and further comprising the step of terminating the operation of the modified program in response to the predetermined event. (Col 14, lines 26-49)

Claim 21: Eggleston discloses the method of claim 20, further comprising the step of allowing each customer to renew the operation of the modified program. (Col 35, lines 3-20)

Claim 22: Eggleston discloses the method of claim 20, further comprising the steps of:

- a. Electronically providing to each customer access to a browsable catalog of previous modified programs of such customer stored in the storage device. (Col 34, line 20 through Col 35, line 37)
- b. Allowing each customer to select via a customer processor one of the previous modified programs or predefined programs stored in the storage device. (Col 34, line 20 through Col 35, line 37)
- c. Allowing each customer to renew via the customer processor the operation of the selected program. (Col 34, line 20 through Col 35, line 37)

Claim 23: Eggleston discloses the method of claim 22, further comprising the step of allowing each customer to modify the selected program. (Col 34, line 20 through Col 35, line 37)

Claim 24: Eggleston discloses a system for allowing multiple customers to each create an individual, modified motivation or recognition program having participants, each said program permitting the participants to earn awards on the basis of the participants' performance, each said program of a particular customer operating according to preferences selected by the particular customer, said system comprising:

- a. A storage device (Col 11, lines 20-35 and Col 14, lines 6-65)
- b. A program processor connected to the storage device, said storage device storing a program for controlling the program processor, said program processor operative with the program wherein the participant processor and the customer processor are remote from said program processor and remote from the storage device:
 - i. To electronically provide to each customer access to a browsable catalog of predefined programs stored in the storage device. (Col 11, lines 20-35 and Col 14, lines 6-65)
 - ii. To allow each customer to electronically select one of the predefined programs stored in the storage device. (Col 11, lines 20-35 and Col 14, lines 6-65)
 - iii. To allow each customer to modify at least one component of the selected predefined program. (Col 11, lines 20-35 and Col 14, lines 6-65)

- iv. To allow each customer to electronically store the modified program in the storage device for access by such customer. (Col 11, lines 20-35 and Col 14, lines 6-65)
- v. To allow each customer to electronically create or review a proposal and/or invoice relating to the modified program. (Col 11, lines 20-35 and Col 14, lines 6-65)
- vi. To allow each customer to operate the modified program. (Col 11, lines 20-35 and Col 14, lines 6-65)
- vii. To provide each customer's participants with access to the modified program stored in the storage device. (Col 11, lines 20-35 and Col 14, lines 6-65)

Claim 52: Eggleston discloses the method of claim 1, further comprising providing each customer with a notification via the program processor when the modified program requires operational maintenance. (Col 35, line 21 through Col 36, line 19)

Claim 53: Eggleston discloses the method of claim 11, wherein the customer specifies a promotion code, and wherein one or more terms associated with the promotion code are applied the purchase by the customer. (Col 34, line 20 through Col 36, line 19)

Claim 54: Eggleston discloses the method of claim 53, wherein the promotion code and the one or more terms is automatically applied to the purchase when the

customer navigates from an affiliate web site. (Col 14, lines 6-65 and Col 34, lines 20-53)

Claim 55: Eggleston discloses a method for allowing multiple customers to each create an individual modified motivation or recognition program having participants, said programs of said multiple customers supplied by a program supplier, each said program permitting the participants to access their program via a participant processor and to earn awards through their program on the basis of the participants' performance, each said program of a particular customer operating according to preferences selected by the particular customer, said method comprising the steps of:

- a. Allowing a first customer via a first customer processor and allowing a second customer via a second customer processor to electronically access a browsable catalog of predefined programs stored in a storage device connected to a program processor, said storage device and said program processor responsive to the program supplier, said storage device and said program processor being remote from said customer processor and remote from said participant processor, wherein the first customer's access and program is independent of the second customer's access and program. (Col 10, lines 28-42; Col 12, lines 38-48; and Col 14, lines 6-65)
- b. Allowing the first customer and the second customer to each electronically select one of the predefined programs stored in the storage device via their customer

processor, wherein the first customer's selection is independent of the second customer's selection. (Col 14, lines 6-65)

- c. Allowing the first customer and the second customer to each electronically modify via their customer processor at least one component of the selected predefined program, wherein the first customer's modification is independent of the second customer's modification. (Col 14, line 66 through Col 15, line 15)
- d. Allowing the first customer to electronically store the first modified program in the storage device for access by the first customer via the first customer processor. (Col 14, lines 6-65)
- e. Allowing the second customer to electronically store the second modified program in the storage device for access by the second customer via the second customer processor. (Col 14, lines 6-65)
- f. Allowing the first customer to operate the first modified program via the first customer processor. (Col 11, lines 20 – 35 and Col 11, line 66 through Col 12, line 11)
- g. Allowing the second customer to operate the second modified program via the second customer processor, wherein the operation of the first modified program is independent of the second modified program. (Col 11, lines 20 – 35 and Col 11, line 66 through Col 12, line 11)
- h. Providing the first customer's participants with access via their participants processor to the first modified program stored in the storage device. (Col 10, line 55 through Col 11, line 7)

- i. Permitting the second customer's participants with access via their participant processor to the second modified program stored in the storage device, wherein access by the first customer's participants to the first modified program is independent of access by the second customer's participants to the second modified program. (Col 10, line 55 through Col 11, line 7)

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eggleston et al. (U.S. Patent Number: 6,061,660) in view of Hoffman and Rogelberg ("A guide to team incentive systems", Team Performance Management, v4n1, pp23, 1998)

Claim 2: Eggleston discloses the method of claim 1, but does not describe the specific criteria used to determine award eligibility. However, Hoffman and Rogelberg discloses a number of group-based approaches that are commonly used to reward employees (Page 2, line 6, through Page 4, line 54). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention

was made to include a criteria in which employees can earn awards based upon the performance of the group. One would have been motivated to include such a criteria in order to encourage cross-departmental cooperation and to provide for a fair and equitable distribution of awards.

11. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eggleston et al. (U.S. Patent Number: 6,061,660) in view of Symons and Jacobs ("A Total Quality Management-Based Incentive System Supporting Total Quality Management Implementation", Production and Operations Management, Vol. 4, No. 3, Summer 1995)

Claim 39: Eggleston discloses the method of claim 1, wherein the allowing each customer to electronically modify includes an award calculator for recommending an award value for one or more participants based upon any sponsor selected criteria. (Col 19, line 56 through Col 20, line 32). Eggleston does not specifically state that an input salary associated with one or more participants is used as a criterion. However, Symons and Jacobs disclose an incentive program that utilizes an employee's base pay in the formula for determining an award (Page 4, Figure 1). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate salary into the formula for calculating an award. One would have been motivated to include salary as a criterion for award calculation in order to provide more valuable rewards to key employees of the

organization. This would aid the organization in retaining key employees by fostering additional good will and loyalty.

Response to Arguments

12. Applicant's arguments filed April 27, 2006 have been fully considered but they are not persuasive.
 - a. The applicant argues that the Eggleston reference fails to teach or suggest allowing a customer to operate the modified program via a program processor, and wherein the participant processor and a customer processor are remote from said program processor and remote from the storage device as recited in Claims 1, 2, 25, and 39. However, the examiner disagrees. Eggleston discloses the use of the "client-server" model of distributed computing in which messages are sent from client computers to one or more servers and incorporates CGI programming for communication between the application and the database (Col 10, lines 28 – 42) (This inherently requires a processor at each machine). Additionally, Eggleston discloses that the application and/or storage device can reside on the Host machine (Col 10, lines 3-9), or on the sponsor machine (Col 12, lines 38-48, and Col 14, lines 6-65)
 - b. The examiner notes that the applicant made an attempt to amend the claims in the proper format required. However, Claim 52 did not contain all of the proper underlining required for an amendment to a previous. The amended Claim 52 contained the phrase "further comprising providing each customer with a

notification via the program processor". This phrase should have read "further comprising providing each customer with a notification via the program processor". The examiner did not feel the error was significant enough to warrant an office action detailing a non-responsive amendment, however the applicant is reminded to follow the amendment practice as described in 37 CFR § 1.121(c) in any future communications.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Van Bramer whose telephone number is (571) 272-8198. The examiner can normally be reached on 9am - 5pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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